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09/777,204	02/05/2001	Jack Ray Caughran	50001-10200	3037

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Patent Docket  
Jenner & Block LLP  
One IBM Plaza  
Chicago, IL 60611

EXAMINER
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CHO, UN C

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 01/05/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/777,204

Applicant(s)

CAUGHRAN ET AL.

Examiner

Un C Cho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Specification***

1. The disclosure is objected to because of the following informalities:

Page 5, line 9 states "Th" it should be "The" instead.

Page 8, line 21 and Page, 9 lines 8 – 9 state "serving cell 309 and MS location 310" they should be "serving cell 310 and MS location 312" instead.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 6 – 12, 16 - 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Dunko et al. (US 6,553,236)

Regarding claim 1, Dunko teaches: A) receiving a request from an affinity group member for geographical zone data for the remote members (Col. 9, lines 19 – 21), wherein the request includes: addressing information (Col. 9, line 27), which inherently includes a mobile subscriber identifier that is associated with the remote members; and a present location of remote members that identifies a

type of predetermined geographical area (Col. 9, lines 31 – 32); and B) returning a reply to the request, wherein the reply includes: location place-name that identifies a current geographical area where the mobile subscriber unit is located (Col. 7, lines 39 – 41) and the current geographical area has the present location of remote members included in the request (Col. 9, lines 31 – 32).

Regarding claim 2, Dunko teaches a network ID that identifies the mobile switching center serving the subscribers (Col. 3, lines 62 – 64).

Regarding claim 6, Dunko teaches the remote members comprising one of a cellular phone, pagers, and personal digital assistants (Col. 3, lines 13 – 16).

Regarding claim 7, the claim is interpreted and rejected for the same reason as set forth in claim 6.

Regarding claim 8, Dunko teaches the present location of remote members identifies one of a shared location place-name description (Col. 8, lines 19 – 23).

Regarding claim 9, Dunko teaches the present location of remote members comprises a request to create a new location place-name description (Col. 8, lines 26 – 27).

Regarding claim 10, Dunko teaches the reply includes a location place-name description with the present location of remote members (Col 7, lines 59 – 65).

Regarding claim 11, the claim is interpreted and rejected for the same reason as set forth in claim 1.

Regarding claim 12, the claim is interpreted and rejected for the same reason as set forth in claim 2.

Regarding claim 16, the claim is interpreted and rejected for the same reason as set forth in claim 8.

Regarding claim 17, the claim is interpreted and rejected for the same reason as set forth in claim 9.

Regarding claim 18, the claim is interpreted and rejected for the same reason as set forth in claim 10.

Regarding claim 19, Dunko teaches a Mobile Position Center (Col. 4, line 64 through Col. 5, line 1) that receives a request for geographical zone data for a mobile subscriber unit, wherein the request includes:

an addressing information (Col. 9, line 27), which inherently includes a mobile subscriber identifier that is associated with the remote members;

a present location of remote members that identifies a type of predetermined geographical area (Col. 9, lines 31 – 32); and wherein the Mobile Position Center (Col. 4, line 64 through Col. 5, line 1) returns a reply to the request, wherein the reply includes: location place-name that identifies a current geographical area where the mobile subscriber unit is located (Col. 7, lines 39 – 41) and the current geographical area has the present location of remote members included in the request (Col. 9, lines 31 – 32).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunko in view of Serbetciouglu et al. (US 5,719,918).

Regarding claim 3, Dunko fails to teach that the request is a transaction control application protocol message and the reply is a transaction control application protocol message. However, Serbetciouglu teaches the request and reply is done by Transaction Capability Application Part (TCAP) protocol (Col. 1, lines 28 - 33). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the teaching of Serbetciouglu to Dunko to provide a method and apparatus using the existing short message signaling mechanisms of a cellular telephone network to exchange information between a plurality of POS terminals, destinations or sources in a secure environment and also to respond to query from a terminal in a timely fashion.

Regarding claim 13, the claim is interpreted and rejected for the same reason as set forth in claim 3.

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6. Claims 4, 5 and 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunko in view of Jampolsky et al. (US 6,625,437).

Regarding claim 4, Dunko fails to teach that the request is received over one of a Internet protocol network and a signaling system seven network and the reply is returned over one of a Internet protocol network and a signaling system seven network. However, Jampolsky teaches the request is received over one of a TCP/IP and a SS7 network and the reply is returned over one of a TCP/IP and a SS7 network (Col. 4, lines 64 – 67). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jampolsky to Dunko to provide a wireless telecommunications network that is operable to collect and report data relating to the status and use of a wireless phone or other telecommunication device in rear real-time in response to data collection requests made by subscribers or other authorized persons.

Regarding claim 5, Dunko teaches that the request is received via a message defined by a GSM standard (Col. 3, lines 19 – 22).

Regarding claim 14, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Regarding claim 15, the claim is interpreted and rejected for the same reason as set forth in claim 5.

***Allowable Subject Matter***

7. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reason for allowance:

Regarding claim 20, Dunko (US 6,553,236), Serbetciouglu et al. (US 5,719,918) and Jampolsky et al. (US 6,625,437), either alone or combination fail to teach a zone manager coupled to the geographical layer interface to receive the request; a location manager coupled to the zone manager to deliver a location of the mobile subscriber unit as determined by a position determination equipment; and wherein the zone manager uses the location of the mobile subscriber unit and a database of zone data to determine the zone identifier.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C Cho whose telephone number is (703)305-8725.

The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703)308-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Un C Cho *UC*  
Examiner  
Art Unit 2682

 12/22/03  
LEE NGUYEN  
PRIMARY EXAMINER